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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,127	12/27/2000	Chunhua Yan	CL000685	4150

25748 7590 01/18/2002

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EXAMINER

FRONDA, CHRISTIAN L

ART UNIT PAPER NUMBER

1652

DATE MAILED: 01/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/748,127

Applicant(s)

Boyd et al.

Examiner

Christian L. Fronda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2, 20, and 21, drawn to a polypeptide, classified in class 530, subclass 385.
  - II. Claim 3, drawn to an isolated antibody, classified in class 530, subclass 387.1.
  - III. Claims 4, 5, 8, 9, 10, 11, 22, and 23, drawn to an isolated nucleic acid, vector, and a method for making a peptide, classified in class 435, subclass 69.1.
  - IV. Claim 6, drawn to a gene chip, classified in class 536, subclass 23.1.
  - V. Claim 7, drawn to a transgenic non-human animal comprising a nucleic acid, classified in class 800, subclass 8.
  - VI. Claim 12, drawn a method for detecting the presence of a peptide comprising contacting a sample with a detection agent that specifically allows detection of the presence said peptide, classified in class 435, subclass 7.1.
  - VII. Claim 13, drawn to a method for detecting the presence of a nucleic acid molecule comprising contacting a sample with an oligonucleotide that hybridizes to said nucleic acid, classified in class 435, subclass 6.
  - VIII. Claims 14 and 15, drawn to a method for identifying a modulator of a peptide comprising contacting said peptide with an agent and determining if said agent has modulated the function or activity of said peptide, classified in class 435, subclass 7.1.
  - IX. Claim 16, drawn to a method for identifying an agent that binds to a peptide comprising contacting said peptide with an agent and assaying to determine whether a complex has formed between the said peptide and agent, classified in class 435, subclass 7.1.
  - X. Claims 17 and 18, drawn to a pharmaceutical composition comprising an agent

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that binds to a peptide and a method for treating a disease or condition mediated by a human drug-metabolizing enzyme protein comprising administering to a patient a pharmaceutically effective amount of an agent that binds to a peptide, classified in class 514, subclass 2.

- XI. Claim 19, drawn to a method for identifying a modulator of the expression of a peptide comprising contacting a cell expressing said peptide with an agent and determining if said agent has modulated the expression of said peptide, classified in class 435, subclass 7.2.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-V and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of the products of Groups I-V and X are independent chemical entities and require different literature searches.

Inventions of Groups VI-IX and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of the processes of Groups VI-IX and XI are distinct both physically and functionally, have different purposes, and require different process steps, reagents, and parameters.

The products of Groups II-V and X are unrelated to each of the processes of Groups VI-IX and XI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of the processes of Groups VI-IX and XI do not require the products of Groups II-V and X.

Inventions I and (VI, VIII, IX, and XI) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as using the peptide in a process to make antibodies toward said peptide.

Inventions IX and X are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such using molecular modeling computer techniques to construct a peptide that binds to said peptide.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

A response to this Office Action may be faxed directly to the Examiner whose Fax Number is (703)746-5036 in order to expedite prosecution.

CLF

  
PONNATHAPU ACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600